



PATENT
Customer Number 22,852
Attorney Docket No. 06556.0003-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
John POLK) Group Art Unit: 3629
Application No.: 09/975,241) Examiner: John Weiss
Filed: October 12, 2001) Confirmation No. 2371
For: METHODS AND APPARATUS)
FOR CHILD SUPPORT)
PAYMENT PROCESSING AND)
CHILD SUPPORT)
DISBURSEMENT PROCESSING)
BY A PROCESSING ENTITY)

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL DECLARATION OF JOHN POLK UNDER 37 C.F.R. § 1.131

1. I, John Polk, am the Applicant of the above-identified application and the inventor of the subject matter described and claimed therein, and I executed and filed a Declaration to that effect on September 29, 1997. In response to an Office Action dated December 3, 2003 in the above-identified application, I also prepared a "Declaration of John Polk Under 37 C.F.R. § 1.131," which I executed on May 28, 2004. Therein, I described facts about the conception of the subject matter of this patent application.

2. It is my understanding that, in a subsequent Office Action dated November 3, 2004, the Patent Office took the position that my declaration (and the cited exhibits) failed to teach three features allegedly set forth in claims 371-483. Specifically, the Patent Office contended that my declaration (and the cited exhibits) did not disclose the following three features: (1) payment information including a debit transaction; (2)

transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary.

3. I am uncertain how the Examiner believes these three features are represented in the pending claims of the present application because the language used by the Examiner is not found in any of pending claims 371-483. The Examiner may have intended otherwise, but the Examiner has not described these alternatives. For example, it is my understanding that the Examiner may have intended that (1) "payment information including a debit transaction" is a feature of claim 371, which does recite a method including "processing from the agency to a bank the child support payment as a debit transaction." As another example, it is my understand that the Examiner may have intended that (2) "transmitting the payment information from an accumulator agency to a bank" is a feature of claim 371, which does recite a method including "processing from the agency to a bank the child support payment as a debit transaction." As yet another example, it is my understand that the Examiner may have intended that the Examiner may have intended that (3) "transmitting disbursement information from the accumulator agency to an intermediary" is a feature of claim 371, which does recite a method including "processing from the agency to an intermediary the child support disbursement information as an addendum transaction." However, despite these possible intentions, these arguments are not made in the Office Action.

4. I thus disagree that the Examiner has demonstrated that each of the pending claims has the three cited features. The three specific features cited by the Examiner do not appear in claim 371, and the Examiner has not addressed the differences. I further disagree that the features recited by the Examiner are present in all of the pending claims. There are some claims within the set of pending claims 371-483, which do not have these features or any arguable variation thereof. To take one example, claim 405 recites "a method of processing a child support disbursement, comprising the steps, performed by a processor, of: receiving at an accumulator agency child support disbursement transaction information from a state regarding the child support disbursement as an addendum transaction; and executing the child support

disbursement to a recipient." Even under the most liberal reading, it is clear that claim 405 does not have any of the three features that have been cited by the Examiner.

5. Nonetheless, regardless of how the Examiner intended to relate the three listed features from the Office Action to the claims of the present application, I further disagree with the Examiner's assertion that my declaration and the cited exhibits failed to teach the cited features. In this supplemental declaration, I address each of these three features and explain how these features were indeed disclosed by my declaration.

6. Exhibits 1 and 2, which were both attached to my initial declaration of May 28, 2004, are true and correct copies of drawings that I prepared prior to October 18, 1996. Those drawings depict aspects of my invention of an accumulator agency for electronically processing wage assignments (i.e., wage assignment orders) from states for employers. See Exhibits 1 and 2 to "Declaration of John Polk Under 37 C.F.R. § 1.131". Copies of these two drawings are attached hereto as Exhibits 1 and 2.

7. Exhibit 1 (entitled "Exhibit 1 The Problem Defined") and Exhibit 2 (entitled "Exhibit 1 Electronic Processing of Wage Assignments") are documentary evidence of conception of at least the three features cited in the October 12, 2004 Office Action. As explained below, Exhibits 1 and 2 teach each of the following three features identified by the Patent Office: (1) payment information including a debit transaction; (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary.

8. First, Exhibits 1 and 2 describe payment information including a debit transaction, particularly given the reference to the "Formatted 521 Records" in Exhibit 2. Exhibit 1 defines the problem of multiple withholding orders from states to employers, and Exhibit 2 describes the solution to the problem, namely, the use by employers of an "accumulator router function" (e.g., an "accumulator agency"). As shown in Exhibit 2, the accumulator agency receives and processes wage assignment orders from states for employers. The textual description at the bottom of Exhibit 2 describes the two parts of a wage assignment order, the record (e.g., "disbursement information") and the electronic payment (e.g., "payment information"). The textual description at the bottom of Exhibit 2 also describes the subsequent processing of the disbursement information

and of the payment information by the accumulator agency. In particular, the accumulator agency processes the disbursement information from the employer to the designated state (e.g., an "intermediary"), and the accumulator agency also processes the payment information from the employer to a bank via "Formatted 521 Records."

9. The reference to use of the "Formatted 521 Records" by the accumulator agency clearly demonstrates two things: (1) use of a debit transaction (not a credit transaction) and (2) processing of the debit transaction to a bank. One of ordinary skill in this field would have known at the time of this invention that 521 records allow for payments using either credit transactions or debit transactions. However, only a bank is able to originate a credit transaction, whereas a non-bank entity (such as, an accumulator agency) is able to originate a debit transaction. Therefore, the reference in Exhibit 2 to "the accumulator/router function permits the receipt and routing of electronic payment transactions from employers" via "Formatted 521 Records" clearly indicates a debit transaction, which is processed by the accumulator agency. (Emphasis added.) In this scenario, the accumulator agency originates the debit transaction on behalf of the employer and the debit transaction is transmitted to the accumulator agency's bank.

10. Second, Exhibits 1 and 2 also describe transmitting payment information from an accumulator agency to a bank due to the reference to "the accumulator/router function permits the receipt and routing of electronic payment transactions from employers . . . [via] Formatted 521 Records." As described above, after a non-bank entity (such as, an accumulator agency) originates a debit transaction for an electronic payment, the electronic payment transaction is transmitted to the bank of the originator for initial processing of the debit (e.g., to the accumulator agency's bank). In this scenario, the debit transaction would then also be transmitted from the accumulator agency's bank to the bank of the debtor (e.g., to the employer's bank) via the ACH (i.e., the automated clearing house). One of ordinary skill in the art would have known that that "Formatted 521 Records" always require a bank for processing; in fact, a debit transaction requires two banks (the bank for the originator and the bank for the debtor).

11. Further, the textual description at the bottom of Exhibit 2 also explains that "[t]he combination of functions create a 'closed loop' operation." This combination of

functions by the accumulator agency refers to the preceding sentence of the textual description of Exhibit 2: "the accumulator/router function permits the receipt and routing of electronic payment transactions from employers . . .[via] Formatted 521 Records." In order for the accumulator agency depicted in Exhibit 2 to "route" electronic payments (e.g., to process payment information) in this "closed loop operation," the payments must be sent to a bank. One of ordinary skill in the art would readily understand this.

12. Third, Exhibits 1 and 2 also describe transmitting disbursement information from the accumulator agency to an intermediary. As described above, the accumulator agency processes the disbursement information from the employer to the designated state (e.g., "the intermediary" of claims 145-252). As shown in Exhibit 1, the problem of multiple withholding orders from states involved "[s]tates send[ing] multiple wage withholding orders (garnishments) to employers that require the employer to adapt to the particular state(s) . . . [with] a paper-based process." Thus, Exhibit 1 clearly depicts the transmission of wage assignments from employers to a designated state (i.e., the "state child support agency" depicted in Exhibit 1, and e.g., an "intermediary"). As shown in Exhibit 2, the solution offered by the accumulator agency was to separate the wage assignment orders into two parts, the record (e.g., "disbursement information") and the electronic payment (e.g., "payment information"). As described above, the accumulator agency then "routes . . . electronic payment transactions" (i.e., processes payment information to a bank). In this closed loop operation, the accumulator also processes disbursement information to the intermediary designated in the wage assignment order. On review of Exhibits 1 and 2, one of ordinary skill in the art would readily understand both of these processes performed by the accumulator agency, specifically including transmitting disbursement information from the accumulator agency to an intermediary.

13. For reasons that I do not understand, with regard to transmitting disbursement information from the accumulator agency to an intermediary, the Patent Office also contends in the Office Action that: "The [disbursement] information could have been sent directly from a payment agency (Bank) or from the employer." I cannot respond to that statement, as it does not address what Exhibits 1 and 2 disclose.

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14. For the foregoing reasons, and based on Exhibits 1 and 2, I believe that one of ordinary skill in this field would understand Exhibits 1 and 2 to disclose the following features: (1) payment information including a debit transaction; (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from the accumulator agency to an intermediary. Thus, I believe there is evidence of conception of at least these features prior to October 18, 1996, i.e., the effective date of U.S. Patent Application No. 08/734,518, titled Electronic Bill Presentment and Payment System, now U.S. Patent No. 6,070,150 ('150 Patent).

15. Accordingly, based on my initial declaration of May 28, 2004 (and the attached exhibits) and on this supplemental declaration, I, John Polk, the inventor of the subject matter described and claimed in the above-referenced patent application, conceived of the claimed invention prior to the effective date of the '150 Patent.

16. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patents issuing thereon.

Dated: May 2, 2005

By:

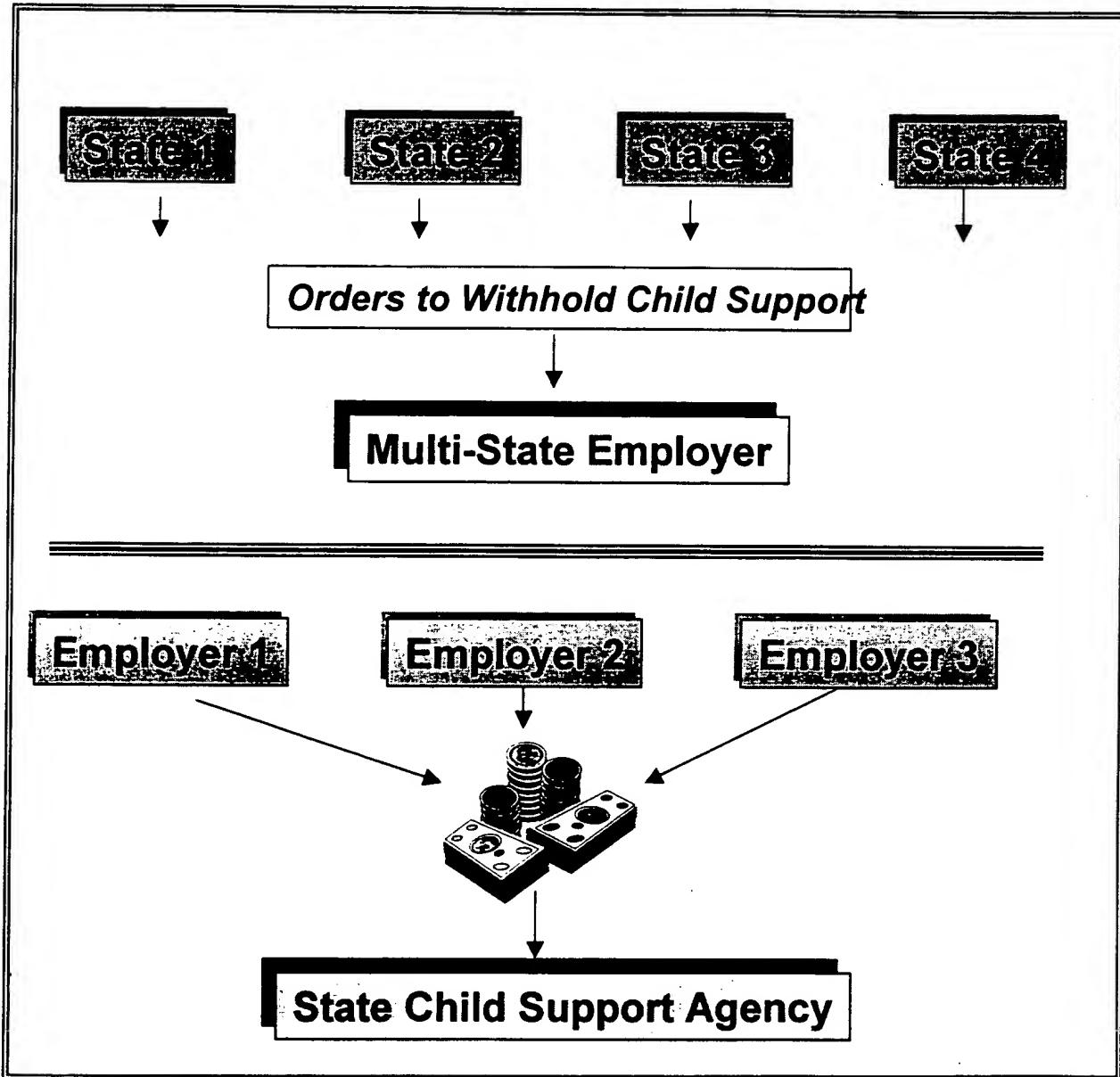

John Polk



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Exhibit 1

The Problem Defined



States send multiple wage withholding orders (garnishments) to employers that require the employer to adapt to the particular state(s).

The employer wants to remit child support payments in one form to all states.

The result of the "do it my way" approach has been a paper-based process.



Exhibit 1

Electronic Processing of Wage Assignments

